REMARKS

Claims 1-20 are pending in this application. By this Amendment, claims 1, 2, 13 and 14 are amended. No new matter is added. Reconsideration of this application is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representatives by Examiner Rohwer and Examiner Zimmerman in the October 19, 2006 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

Specifically, the claims have been amended to selectively recite "any network" in place of "a network," as suggested by Examiner Zimmerman. Further, arguments are presented similar to those addressed during the interview that the White/Chandar combination is improper, but that even if combined, the White/Chandar combination fails to teach or suggest the combinations of features recited in the claims, as addressed in detail below.

I. Rejections

The Office Action rejects claims 1-4, 6, 8-11, 13-15 and 18-19 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2003/0074312 to White ("White") in view of U.S. Patent Application Publication No. 2003/0004886 to Chandar et al. ("Chandar"); rejects claims 5 and 16 under 35 U.S.C. §103(a) over White and Chandar in view of U.S. Patent Application Publication No. 2002/0069168 to Lee et al. ("Lee"); rejects claims 7 and 17 under 35 U.S.C. §103(a) over White and Chandar in view of asserted commonly known art at the time of the invention; and rejects claims 12 and 20 under 35 U.S.C. §103(a) over White and Chandar in view of U.S. Patent Application Publication No. 2003/0149661 to Mitchell et al. (Mitchell). These rejections are respectfully traversed.

Independent claim 1 recites a method of performing a billing process for the copies or prints produced by a customer of a printing system that includes, among other features, a) in

the printing system, accessing the memory to retrieve said product usage data without communicating over any network; b) in the printing system, calculating billing data using the retrieved product usage data without communicating over any network; c) in the printing system, presenting a bill to the customer based on said billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network; d) in the printing system, receiving authorization information indicating whether the customer authorizes the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network; and e) if said authorization information indicates that the customer has authorized the billing data, sending a message from the printing system to a billing service over a network, the message including information indicating the authorized billing data.

The Office Action acknowledges that White does not teach accessing a memory to retrieve said product usage data without communicating over any network and acknowledges that White does not teach calculating billing data using the retrieved product usage data without communicating over any network, but relies upon Chandar to teach these features.

Applicant asserts that White also does not teach or suggest: (1) in the printing system, presenting a bill to the customer based on said billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network; or (2) in the printing system, receiving authorization information indicating whether the customer authorizes the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network, as recited in claim 1.

Further, Applicant asserts that Chandar cannot reasonably be considered to teach, or to have suggested, such features.

For at least the reasons addressed below Applicant asserts that the combination of White and Chandar is improper. Further, Applicant asserts that, even if combined, the White and Chandar combination would not teach the combination of features recited in claim 1.

A. Applied Prior Art Does Not Teach All Recited Features

1. Chandar Does Not Teach Verifying Charges with a Client

As described in Chandar at paragraph [0039], the resource cost calculator in Chandar initiates only _after_ a user logs off. Therefore, 1) a customer of the system described in Chandar is not presented with a bill based upon the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network, and 2) the system in Chandar does not provide a client with an opportunity to authorize the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network, as recited in claim 1.

Therefore, even if White and Chandar were combined, the combination would not teach, or have suggested, the combination of features recited in claim 1.

2. White/Chandar Does Not Teach or Suggest Recited Product Usage Data

As addressed above, Chandar does not teach a method of performing a billing process for the copies or prints produced by a customer of a printing system, rather, as stated in Chandar at paragraph [0015], Chandar teaches a method of public access computing, i.e., a selective access computing system that insures that only paying customers use the computer system. The computing system in Chandar is not a printing system as described in the present application, rather a computer, e.g., with network access and/or peripherals. Such a

selective access computing system is different from the printing system described in the present application.

The present application at page 5, lines 2-6, states that the copy count is product usage data that indicates a measurement of the actual use of the printing system. Other common product usage data include meter readings, information on the use of printing sub-systems such as sub-units for binding, scanning, stapling, stitching, shrink wrapping, etc and a measure of the paper and toner consumption. Nowhere does Chandar teach or suggest a resource tracker that records a copy count or other such product usage data that indicates a measurement of the actual use of the printing system, i.e., a copy count, as recited in the claims.

For example, as addressed above, the resource tracker in Chandar does not track number of copies printed, but merely, the number of requests by user to use the input/output devices so that the user can be charges for use of each input/output device. Nowhere does Chandar teach or suggest that, with respect to a printer, the number of requests by user correlates to a copy count.

Therefore, even if White and Chandar were combined, the combination would not teach or suggest all of the features cited above with respect to claim 1, because the White/Chandar combination would not teach or suggest a local resource tracker that includes product usage data sufficient to indicate a measurement of the actual use of a printing system, as recited in claim 1.

3. Chandar Relies Upon A Network Connecton

As described in Chandar at paragraph [0015], to assure that only paying customers use the computer system, the computer system operates in a locked mode until the computer system receives a signal from the electronic payment mechanism that the customer has

payment authorization. As stated in paragraph [0026], the financial database 24 that

determines whether the customer has payment authorization preferably comprises <u>a financial</u>

<u>institution and/or financial services network</u>. If the system in Chandar is unable to determine

whether the customer has payment authorization, the user will not be allowed access to the

computer system. Therefore, the system in Chandar is reliant upon a network connection in

order to provide service to a client. Such an approach is contrary to a goal of the present

application, as stated at page 2, lines 9-24, which is to avoid a system that is susceptible to

transmission errors.

Therefore, even if combined the White/Chandar combination cannot reasonably be

considered to teach or suggest accessing the memory to retrieve said product usage data

without communicating over any network, or calculating billing data using the retrieved

product usage data without communicating over any network, as recited in claim 1, because

communication over a network is prerequisite to obtaining access to the selective access

computing system.

B.   White/Chandar Combination is Improper

1.   White Must be Considered "As a Whole"

The Manual of Patent Examining Practice (MPEP) at Section 2141.02, entitled, "The

difference between the prior art and the claimed invention," states at subsection 2141.02.I

that the claimed invention as a whole must be considered. Specifically, the MPEP states that,

in determining the differences between the prior art and the claims, the question under 35

U.S.C. 103 is not whether the differences themselves would have been obvious, but whether

the claimed invention as a whole would have been obvious.

The Office Action ignores this guidance. By asserting that one of ordinary skill in the

art would modify White in view of Chandar to include accessing a memory to retrieve said

product usage data without communicating over any network and calculating billing data using the retrieved product usage data without communicating over any network, the Office Action ignores the teaching of White as a whole.

For example, as described in White at paragraphs [0004], [0005] and [0014]-[0017], White is directed to "an electronic transaction recording system [that] accumulat[es] data **from** printer devices" and that "manages billing policies attributed to each printer device." Features and operation of such a transaction recording system are described in White at least at paragraphs [0021]–[0025] and Fig. 2. The described processes clearly demonstrate that White relies upon network connections between the printer device 12 and the described billing manager 4.

Therefore, to modify White as proposed by the Office Action is contrary to the specific teaching of White and ignores the teaching of White as a whole.

2.   **Chandar Must Be Considered In Its Entirety**

The Manual of Patent Examining Practice (MPEP) at Subsection 2141.02.VI that the prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. The Office Action ignores this guidance.

For example, Chandar does not teach a method of performing a billing process for the copies or prints produced by a customer of a printing system, rather, as stated in Chandar at paragraph [0015], Chandar teaches a method of public access computing, i.e., a selective access computing system that insures that only paying customers use the computer system. The computing system in Chandar is not a printing system as described in the present application, rather a computer, e.g., with network access and/or peripherals.

For example, as described in Chandar, at paragraphs [0017] and [0023] the computing system in Chandar includes a resource tracker that includes a system usage timer 70, resource

cost calculator 72, and input/output request counter 74. Input/output request counter 74 comprises a module that tracks the number of requests by user to use input/output devices 26 so that the user can be charged for use of each input/output devices 26, such as printer 100, scanner 102, fax 104, copier 106, digital sender 108, and DVD player 116.

As described in Chandar at paragraph [0039], the resource cost calculator in Chandar initiates only after a user logs off. Therefore, 1) a customer of the system described in Chandar is not presented with a bill based upon the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network, 2) the system in Chandar does not provide a client with an opportunity to authorize the billing data, the billing data having been calculated without communicating over any network based upon said product usage data retrieved without communicating over any network, and 3) the system in Chandar does not receiving authorization information indicating whether the customer authorizes the billing data or 4) send a message from the printing system to a billing service over a network, the message including information indicating the authorized billing data, if the billing is authorized, as recited in claim 1.

The Office Action relies upon features taken from Chandar without consideration of Chandar as a whole, and thereby ignores specific teaches of Chandler which are contrary to the features recited in claim 1.

3.   **Improper Use of Hindsight Reasoning**

As addressed above, Chandar does not teach a method of performing a billing process for the copies or prints produced by a customer of a printing system, rather, as stated in Chandar at paragraph [0015], Chandar teaches a method of public access computing, i.e., a selective access computing system that insures that only paying customers use the computer

system. The computing system in Chandar is not a printing system as described in the present application, rather a computer, e.g., with network access and/or peripherals.

The selective access computing system is different from the printing system described in the present application. The Office Action engages in improper hindsight reasoning by asserting that it would have been obvious to one of ordinary skill in the art to modify the printing system described in White with the features described in Chandar with respect to a selective access computing system.

4. Prima Facie Case of Obviousness Has Not Been Established

The Office Action's conclusory statement that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a local usage tracker and cost calculator as taught by Chandar in order to present the billing data and receive payment as taught by White so that a correct bill can be generated and presented to the user for payment, in view of the arguments presented above, is not enough to prove that there is a teaching, suggestion or motivation in the prior art to combine these references in the manner suggested by the Office Action.

The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.) (quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). The above conclusory statement is a mere assertion that does not meet the standard of some articulated reasoning with some rational underpendings to support the legal conclusion of obviousness.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claim 1 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine the references.

It is well settled that a rejection based on 35 U.S.C. §103(a) must rest on a factual basis which the USPTO must supply, and it is impermissible for the Examiner to engage in hindsight reconstruction of the prior art using the Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious. The Office Action fails to meet this burden.

C.   **Summary**

For at least the above reasons, Applicant asserts that the combination of White and Chandar is improper, and even if combined, the combination does not teach or suggest all the features recited in the claim 1. Accordingly, it is respectfully submitted that independent claim 1 is patentably distinguishable over the applied art. Claim 13 includes features similar to the features addressed above with respect to claim 1 and, therefore, is patentably distinguishable over the applied art for at least the same reasons addressed above with respect to claim 1. Claims 2-12 and 14-20 depend collectively from one of claims 1 and 13 and are

likewise patentably distinguishable over the applied art for at least their dependence on allowable base claims, as well as for additional features they recite.

Lee and Mitchell fail to overcome the above-described deficiency of the White/Chandar combination. Further, should any rejection relying on "Official Notice" be maintained, Applicants require that a reference be provided in support of this assertion.
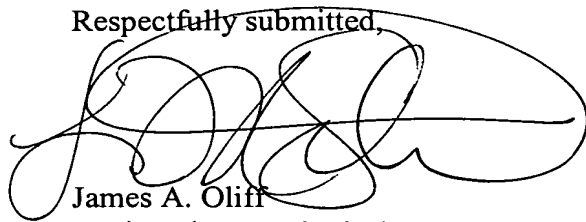
Accordingly, reconsideration and withdrawal of the rejection of claims 1-4, 6, 8-11, 13-15 and 18-19 under 35 U.S.C. §103(a) over White in view of Chandar; the rejection of claims 5 and 16 under 35 U.S.C. §103(a) over White and Chandar in view of Lee; the rejection of claims 7 and 17 under 35 U.S.C. §103(a) over White and Chandar in view of asserted commonly known art at the time of the invention; and the rejection of claims 12 and 20 under 35 U.S.C. §103(a) over White and Chandar in view of Mitchell are respectfully requested.

II.   Conclusion

In view of the foregoing, it is respectfully submitted that this application is in

condition for allowance. Favorable reconsideration and prompt allowance of claim 1-20 are

earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place

this application in even better condition for allowance, the Examiner is invited to contact the

undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Linda M. Saltiel
Registration No. 51,122

JAO:JMH

Date: October 27, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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